

THIS DISPOSITION IS NOT
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MAY 19, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Gilbarco, Inc.**

Serial No. 74/676,293

Kenneth R. Schaefer of Norris, McLaughlin & Marcus for applicant.

Alan C. Atchison, Trademark Examining Attorney, Law Office 102
(**Myra K. Kurzbard**, Managing Attorney).

Before Seeherman, Hanak and Hohein, Administrative Trademark
Judges.

Opinion by **Hohein**, Administrative Trademark Judge:

Gilbarco, Inc. has filed an application to register the
term "SMARTPAD" as a trademark for "electronic security devices
comprising computer memory and microcontroller elements and
encryption software for encrypting data entries for use in
connection with automated fuel dispensers."¹

¹ Ser. No. 74/676,293, filed on May 1, 1995, which alleges a bona fide
intention to use the term.

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that, when used in connection with applicant's goods, the term "SMARTPAD" is merely descriptive of them.²

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys an immediate idea of the ingredients, qualities, characteristics, features, functions, purposes or uses of the goods or services. See, e.g., In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. See In

² Although the Examining Attorney also made final a requirement that applicant clarify the identification of its goods, such requirement

re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Thus, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985).

Applicant states that the term "SMARTPAD" is suggestive rather than merely descriptive of its goods, arguing that:

The LEXIS/NEXIS search made by the Examiner, as well as the dictionary references, clearly demonstrates [sic] that there is no basis to conclude that a purchaser of products in the automated fuel dispenser market (the market recited in the statement of goods) would reach an immediate understanding or thought that the apparatus marketed [as] SMARTPAD was an "electronic security device ... comprising encryption software for encrypting data entries ... etc." as stated in the description of goods.

The only actual use of smartpad relied upon by the Examining Attorney, as found in the LEXIS/NEXIS search, is for a significantly different type of device (a set of "soft" function keys on a display device which are operated by a mouse click).

The Examining Attorney, on the other hand, maintains that, as shown by the evidence he has made of record, "purchasers will immediately understand that the applicant's goods contain microcontroller electronic elements and a pad. As such, in relation to the applicant's goods, the [combination of the] terms ['SMART' and 'PAD' into the designation] 'SMARTPAD' will immediately describe features of the goods and therefore the proposed mark is merely descriptive".

In support of his position, the Examining Attorney has furnished copies of definitions from (1) the Microsoft Press

was subsequently withdrawn.

Computer Dictionary (2d ed. 1994), which at 363 defines the word "smart" as signifying "[a] synonym for *intelligent*; in relation to software or hardware, capable of processing information, typically beyond what is currently expected";³ (2) Webster's New World Dictionary of Computer Terms (3d ed. 1988), which at 348 lists the word "smart" as meaning "[h]aving some computational ability of its own. Smart devices usually contain their own microprocessors or microcomputers"; (3) the IBM Dictionary of Computing (10th ed. 1994), which at 491 indicates that the term "pad" means, among other things, "damping pad, key pad"; and (4) The Random House Unabridged Dictionary (2d ed. 1993), which at 1052 sets forth the designation "key pad" as connoting "1. a separate section on some computer keyboards, grouping together numeric keys and those for mathematical or other special functions in an arrangement like that of a calculator. 2. a panel similarly keyed and used in conjunction with a television set, electronic banking machine, or other electronic device. Also called **numeric keypad**."⁴ In addition, as a further aid to

³ We judicially notice that the latest available edition of such reference work, namely, the Microsoft Press Computer Dictionary (3d ed. 1997), lists the term "smart" at 439 as an adjective signifying "[a] synonym for intelligent. See intelligence." Such dictionary defines "intelligent" at 256 as an adjective meaning "[o]f, pertaining to, or characteristic of a device partially or totally controlled by one or more processors integral to the device" and sets forth "intelligence" at 255-56 as a noun connoting, *inter alia*, "1. The ability of hardware to process information. A device without intelligence is said to be dumb; for example, a dumb terminal connected to a computer can receive input and display output but cannot process information independently."

⁴ Such dictionary, we judicially notice, also defines the term "smart" at 1803 as signifying, in relevant part, "17. *Informal*. equipped with, using, or containing electronic control devices, as computer systems, microprocessors, or missiles: a smart phone; a smart copier."

understanding the issue raised by the terminology and product involved in this appeal, we judicially notice⁵ that the Computer Dictionary (3rd ed. 1992) at 359 defines the word "smart" as meaning "[h]aving some computational ability of its own. Smart devices usually contain their own microprocessors. A synonym for intelligent," while The Computer Glossary (7th ed. 1995) at 214 lists the term "keypad" as denominating "[a] small keyboard or supplementary keyboard keys; for example, the keys on a calculator or the number/cursor cluster on a computer keyboard" and at 248 sets forth the term "microcontroller" by referring to "[s]ee MCU," which at 241 defines such term as signifying "(1) (MicroController Unit) A control unit on a single chip".

The Examining Attorney, as additional support for his position, has submitted the two most pertinent stories retrieved from his search of the "NEXIS" computerized data base.⁶ Such stories, which appeared in separate publications by the same publisher, indicate in pertinent part that (**emphasis added**):

A **smartpad** is a mini window that **looks like a keypad and includes ... the most**

18. Computers. intelligent (def. 4)," the latter of which is in turn defined at 991 as meaning "**4. Computers.** pertaining to the ability to do data processing locally; smart: *An intelligent terminal can edit input before transmission to a host computer.*"

⁵ It is settled that the Board may properly take judicial notice of dictionary definitions, including definitions in technical reference works. See, e.g., In re Hartop & Brandes, 311 F.2d 249, 135 USPQ 419, 423 (CCPA 1962); Hancock v. American Steel & Wire Co. of New Jersey, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); and University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

⁶ Specifically, on July 29, 1996, the Examining Attorney searched the "CURNWS," "CMPTRS" and "TECHNY" files of the "CMPCOM" library using the search request "SMARTPAD OR SMART PAD".

commonly used AS/400 functions, which can be accessed with once [sic] of the mouse. The best **smartpads** provide a good default set up for the user, but also allow a lot of customization by the u[sers to] add their own frequently-used commands. -- LAN Computing, February 1994 at S8 (article headlined in part: "Navigating LAN connections: AS/400 connectivity calls for the proper software, user interface and administrative features"); and

Features include automatic window and font sizes, macro recorder that sends a sequence of keystrokes to the host via the mouse, and **smartpad** keys that can invoke macros or AS/400 functions. -- MIDRANGE Systems, September 14, 1993, at 50 (article headlined in part: "Attachmate's NetWare 5250 LAN Workstation for Windows terminal emulation software")

In view of the above, and given the ubiquitous nature of microcontroller-based, microprocessor-operated and computer-controlled items in all facets of commercial as well as everyday life, it is our view that, when applied to "electronic security devices comprising computer memory and microcontroller elements and encryption software for encrypting data entries for use in connection with automated fuel dispensers," the term "SMARTPAD" immediately describes, without conjecture or speculation, a significant characteristic or feature of applicant's goods, namely, the intelligent keypad used for encrypting data in connection with automated fuel dispensers. As previously noted, it is simply not necessary that a term describe every characteristic, feature, purpose, function, ingredient, quality or other aspect of a product in order for it to be merely descriptive. It is sufficient, instead, if the term, as here, describes one significant attribute of the product, such as a

characteristic or feature. See, e.g., In re Venture Lending Associates, 226 USPQ 285, 286 (TTAB 1985); In re Aid Laboratories, Inc., 223 USPQ 357, 358-59 (TTAB 1984); In re H.U.D.D.L.E., 216 USPQ 358, 359 (TTAB 1982); and In re MBAssociates, 180 USPQ 338, 339 (TTAB 1973).

Plainly, to purchasers of automated fuel dispensers and/or those concerned with electronic security devices for encrypting data entries with respect to such dispensers, there is nothing in the term "SMARTPAD" which is ambiguous, incongruous, indefinite or too abstract. No degree of imagination, cogitation, mental processing or gathering of further information is necessary in order for those persons to perceive the merely descriptive significance of such term as it relates to a key feature of applicant's product, namely, a smart pad, which provides the user with the ability to have data pertaining to automatic fuel dispensing encrypted as it is entered by means of a keypad. Clearly, when joined together, the individual terms comprising the term "SMARTPAD" have a meaning, as shown by the dictionary definitions thereof, which is identical to that which ordinary usage would ascribe to those terms in combination. See In re Gould Paper Corp., 824 F.2d 1017, 5 USPQ2d 1110, 1112 (Fed. Cir. 1987).

Although applicant asserts in its reply brief that "there is not the slightest hint or suggestion in the name 'SMARTPAD' that ... encryption software is included in the goods," the dictionary definitions of the word "smart" plainly are broad enough to encompass such information processing ability

as encryption software of all types, including that for automatic fuel dispensers. Moreover, as to applicant's further contention that "[t]here is no reference to a 'pad' in the recited goods," the Examining Attorney accurately observes in his brief that "applicant has not denied that its goods consist in part of a keypad, numerical entry pad, panel or other data entry pad" Indeed, applicant concedes in its reply brief that its "overall system does include a user operated data entry device in the form of an array of geometric areas with a number in each area," which statement is simply a verbose admission that its product contains a numeric keypad or "pad" for short. Thus, as pointed out by the Examining Attorney, "applicant's goods do in fact comprise a pad and ... [s]uch goods fall within the broad definitions ascribed to the word 'PAD'." Purchasers and users of applicant's goods, therefore, will immediately perceive the term "SMARTPAD," when used in connection with such goods, as describing an intelligent keypad, which constitutes an important characteristic or significant feature of the goods. See, e.g., In re Cryomedical Sciences Inc., 32 USPQ2d 1377, 1379 (TTAB 1994) ["SMARTPROBE" held merely descriptive of "one time use, disposable cryosurgical probes"].

Finally, we note that the fact that applicant will or intends to be the first entity to use the term "SMARTPAD" in connection with its particular goods is simply not dispositive where, as here, such term unequivocally projects a merely descriptive connotation. See In re MBAssociates, 180 USPQ 338, 339 (TTAB 1973). As is plain from the analogous stories

retrieved by the Examining Attorney from the "NEXIS" database, the designation "smartpad," when utilized in reference to a set of function keys arrayed as a keypad on a computer display and operated by mouse clicks thereon, merely describes but another version or kind of intelligent keypad which differs from applicant's product only in the manner of its operational function rather than in its basic data entry purpose. Both products, as the Examining Attorney persuasively points out, "feature ... 'smart' functions introduced by means of or contained within a 'pad' or panel." Thus, the term "SMARTPAD," whether applied to an aspect of applicant's product or to a keypad of the type mentioned in the "NEXIS" articles, projects the same merely descriptive significance in either instance.

Accordingly, because the term "SMARTPAD" conveys forthwith an immediate idea of a significant characteristic or feature of applicant's products, namely, the intelligent keypad of its electronic security devices for encrypting data entries for use in connection with automated fuel dispensers, such term is merely descriptive within the meaning of the statute.

Decision: The refusal under Section 2(e)(1) is affirmed.

E. J. Seeherman

E. W. Hanak

G. D. Hohein

Ser. No. 74/676,293

Administrative Trademark Judges,
Trademark Trial and Appeal Board